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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,753	06/06/2001	Olaf Vancura	1498/198(b)	8046

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DORR CARSON SLOAN & BIRNEY, PC
3010 EAST 6TH AVENUE
DENVER, CO 80206

EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 06/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,753

Applicant(s)

VANCURA, OLAF

Examiner

William M Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,8-10,18,19,24,25 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 8-10, 18, 19, 24, 25 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

WILLIAM M. PIERCE
PRIMARY EXAMINER

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DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1, 3, 8-10, 18, 19, 24, 25 and 30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in the previous office action and below in response to applicant's remarks.

Claims 1, 3, 8, 9 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons set forth in the previous office action and below in response to applicant's remarks.

Claim Rejections - 35 USC § 102

Claims 1, 3 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Keller and in the alternative 2,197,974 as set forth in the previous office action and below in response to applicant's remarks.

Claim Rejections - 35 USC § 103

Claims 8-10, 19, 24, 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller and 2,197,974 in view of Thompson as set forth in the previous office action and below in response to applicant's remarks.

Response to Arguments

Applicant's arguments filed 5/3/02 have been fully considered but they are not persuasive.

Examiner notes applicant's efforts to advance the prosecution of the case by reducing the number of claims and filing a terminal disclaimer.

CLAIM REJECTIONS-112

Applicant's interpretation of the meaning of the word "combination" is noted. However, the examiner does not wish to engage in a study of the word "combination". The word must be read in light of the context used in the claim and the specification. More specifically the context of the claim calls for "using the answers from a player in combination with the underlying game of chance". Nowhere in the specification are the answers "used" in any way

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"with" the game of chance. The specification describes the basic game and the secondary game as being "separate. In short, it is not possible to determine the mete and bounds of the claim and it remains rejected as indefinite.

Applicant's remarks do not directly address the rejection made with respect to 35 UC 112, first paragraph. Applicant's remarks have not satisfied examiners concerns where the scope of the claims extend beyond that of the specification. As such this rejection remains.

CLAIM REJECTIONS-102

With respect to Keller, applicant argues the notion of a "house advantage within a predetermined range". First a "house percentage" is inherent to all casino formatted wagering games. This is (as applicant states at top of pg. 6 of his remarks) "a percentage of the wager retained by the house for the privileges of playing the games." As presented by applicant the mathematics "provides a commercially viable casino game". The examiner's position is that such an argument is inherent to the design of casino games. While the above applied references fail to discuss the house percentages claimed. The house percentage in chance game such as slots relates to mathematics well known to one skilled in the art of gaming. When a "basic game" is combined with a "secondary game", (It is noticed that in the gaming industry "secondary event slot machines" (term coined in col. 3, ln. 1 of 6,231,442) having a bonusing game with a "basic game" is well known. The background section of PGPUB 2002/0039918 further sets forth this trend in gaming. Multipliers in secondary games are known (For example in patents to Adams such as 5,848,392). Further known is where the winnings based on the outcome of the secondary game is accumulated by adding or subtracting or awarded along with to the winnings of the basic game. (See Vancura 6,033,307 for example.)) the mathematics of each game are considered synergistic. It would be routine for one skilled in the art to either determine the house percentage or design the game to a specific house percentage or range. Were there is a skill type game it is well known that a players abilities are going to range from novice to expert. Using matters of common knowledge and common sense of the person of ordinary skill in mathematics as it would pertain to gaming has been held obvious. (See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). A game designer is presumed to have the skill to determine a favorable house percentage to both the house and the players. It is clear that game designers would not design a game that would have an "unfavorable" house percentage. Designers attempt to design house percentage that balances maximum profits for the house verses player interest. In addition, in evaluating a reference, it is proper to take into account not only the specific teaching of the reference(s) but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Clearly, in Keller, one skilled in the

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art would expect that the game disclosed therein would be designed to generate a predetermined profit for the house. Additionally, one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962)).

As to the middle of pg. 6, applicant's analysis of Keller is incomplete. Keller is aware that his combined game can be designed as a casino game as he sets forth in his background. His contribution to the art takes ordinary casino games beyond by preventing them from being used as a game of chance. His motivation to do this is to circumvent gaming laws in certain jurisdictions. He clearly recognizes that traditional house percentage and player rewards are known, but make the games unlawful in certain areas. Inherent in Keller is what is known to casino games in general, that they traditionally are designed with a house percentage. Keller shows a way that the traditional combined games can be combined in a new way to prevent them from being used "as a game of chance (as in a traditional casino game)."

To the extent that applicant alleges "hindsight" to argue the finding of inherency, the "inherent characteristic" of "house percentage" and what role it play in the design of casino games is in no way a "gap" in the reference. As set forth above, it is a controlling variable in the design of wagering games. Further, in establishing inherency, the evidence, as set forth in arguments above make clear that the concept of a "house percentage" is necessarily present in Keller. It would be clearly so recognized by persons of ordinary skill.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Applicant's remarks with respect to Walker are based on the same rational that "there is no disclosure in Walker of a house advantage with a predetermined range". For the reasons set forth above, such is considered well known to a game designer and is inherent. Walker clearly recognizes that a players skill will reduce the house percentage as set forth by the applicant. The trivia game in Walker allows a Player to "achieve higher rewards" than would have been just won by the slot machine. The rewards (or inherent house percentage) are a function of the reel position and a player response. The predetermined range for each reel position would be in a range from a reward for a player giving the wrong answer to a player giving a correct answer. Clearly one skilled in the art would not contemplate designing the play of Walker to lose money for the house. A person guessing incorrectly all the time would receive only the payouts for a particular reel position and a player guessing correctly all the time would always increase their rewards for particular reel positions. As in applicant's invention, the house will profit more from less knowledgable

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players and profit less from those with more or perfect knowledge. Applicant's accretion that "no extrinsic evidence has been provided" is unconvincing since a "house percentage" in the design of wagering game is well founded in the art as a whole. The limits of the house percentage of a game are set by law as well as the desire to obtain profits and attract players.

As to claims 3 and 30, Walker sets forth that "the player could be allowed a predefined period after the reels stopped spinning to enter and answer" (col. 11, ln. 22). Such meets the limitation of the claims.

Whether or not a player "risks a portion of the payoff" is moot since such does not pertain to limitations in the claims.

Applicant's arguments with respect to 2,262,642 parallel those previously set forth. Applicant's remarks with respect to Blackjack are considered moot since the claims are not drawn to a blackjack game. The "commercial viability" of a machine is affected when it fails to generate an adequate profit for the house, or as stated '569 as "excessive kill depressing machine income" (pg. 3, ln. 24). Applicant has not demonstrated where the income from his machine will be commercially viable at a point where knowledgeable players have depressed its income below a level acceptable to the house. The problem in both Walker and '569 are with a machine "maintaining acceptable profits to the house" in the presence of knowledgeable players. Applicant has provided no evidence that his machine will remain commercially viable in the presence of such players. A "predetermined range" does not solve any problem. Each of the applied references inherently have a predetermined range and the range that is deemed acceptable to commercial viability is subjective.

The subjective opinions of Gushin do not set forth facts. The fact that he is not aware of the prior art applied in this case and the mere praise for a device does not offer evidence of patentability.

Grochowski never refers to the invention as set forth in the claims. Further, the fact that Mr. Grochowski is not familiar with the prior art as applied above is not indicative of patentability.

CLAIM REJECTIONS-103

The scope of claim 8 pertains to how one engages in the bonus game. Both Keller and Thompson are considered to fall within the category of machines known in the art as "secondary event slot machines". As such their combination is considered proper. Known in these types of machine is allowing an event, time interval or random event to trigger the "secondary event". This manner in which a player goes from the "basic game" to the "secondary game" is a matter of choice not shown critical to the claimed invention by solving any particular problem or producing any unexpected results.

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Applicant's Evidence of State of the Art clearly provides evidence to show why overly broad claims (such as claim 1 which merely receives a wager, plays a game of chance and plays a knowledge based game) cannot be patentable. Such is evidence of the large stock of prior art which can anticipate or meet the pending claims as being obvious.

Strictly Slot further shows the lack of patentable advance in the claimed invention. One must first consider the State of Art of Bonus game in general. It is considered well established that using a bonus game, where the secondary game is a knowledge based game, is known. Such is set forth in the application of Walker under 102 (and applicant supplied reference to "Slots of Trivia" from 1996). The art as a whole shows that the winnings from a secondary game can be awarded with the winnings from the base game, modify the winnings from the base game, multiply the winning of the base game and/or not affect the winnings of the base game at all. Ripley's Believe It Or Not uses the secondary bonus game in the traditional fashion the "multiply" the previous winnings from the basic game (as in the group of patents to Adams set forth above).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.

Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is Customerservice3700@uspto.gov.

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

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Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM M. PIERCE
PRIMARY EXAMINER